

REMARKS/ARGUMENTS

Claims 1-24 remain in the application. No new matter has been added. Consideration and examination is respectfully requested.

1. REJECTION OF CLAIMS 1-19 & 21-24 UNDER U.S.C. § 102:

In the section entitled "Claim Rejections - 35 U.S.C. § 102" on page 2 of the Office Action mailed on 24 November 2004 (Paper No./Mail Date 20041119) referred to hereinafter as the Office Action of 24 November 2004, claims 1-19 and 21-24 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by *Akasheh* in U.S. Patent Number 6,134,674 entitled "Computer Based Test Operating System" hereinafter *Akasheh*. Applicant respectively traverses.

As stated in MPEP 2131 "To anticipate a claim, the reference must teach every element of the claim." As will be shown in the following paragraphs, *Akasheh* fails to teach every element of claims 1-19 and 21-24.

Regarding Rejection of Independent Claim 1 Under 35 U.S.C. § 102:

Among other items, *Akasheh* does not disclose instructions for directing a processing unit to "receive a selected one of a plurality of previously created alternative specifications for assessing a datapoint generated by a test, wherein each of the plurality of alternative specifications is a different specification for assessing the datapoint" as claim 1 of the Present Application does. The Office Action of 24 November 2004 alleges that *Akasheh* "discloses a test file which stores associated tolerances for testing (see column 2 lines 52-54) and further states the user may select various test tolerance criteria (see column 9 lines 16-18)."

However, in the cited sections, *Akasheh* discloses that "A test file stores the test data, test step names, device parameters and associated tolerances used for testing a UUT." Note that *Akasheh* indicates for each parameter only ONE associated tolerance condition. A plurality of tolerances is associated with a plurality of device parameters, but *Akasheh* does NOT indicate more than one tolerance condition associated with one device parameter. Also, in the cited sections, *Akasheh* discloses that "In step 207, a user may select various test tolerance criteria for testing the UUTs using the tolerance manager (TM)." In *Akasheh*, a User uses the tolerance manager to set the tolerance condition for a given parameter of interest. *Akasheh* does NOT disclose an instruction for receiving "a selected one of a plurality

of previously created alternative specifications for assessing a datapoint generated by a test, wherein each of the plurality of alternative specifications is a different specification for assessing the datapoint" wherein the datapoint is representative of *Akash*'s parameter. The User in *Akash* employs the tolerance manager to set the tolerance condition for a given parameter and then applies that condition to the test to be conducted. A "plurality of previously created alternative specifications" for each parameter was NOT disclosed in *Akash*.

The second paragraph on page 8 of the Office Action of 24 November 2004 alleges that "*Akash* discloses a test file which stores associated *tolerances*" which indicates "a plurality of alternative specifications". However, this is NOT the case. In fact *Akash* does NOT indicate ALTERNATIVE specifications. He instead indicates ONE associated specification condition for EACH of multiple parameters. This is not the same as alternative specifications for any given parameter.

Applicant maintains that *Akash* does NOT disclose the selection of "one of a plurality of previously created alternative specifications" which can be used for a particular datapoint. In *Akash* each of the instruments 112.sub.1 ... 112.sub.N individually measures a separate item analogous to a datapoint of the Present Application and each of the instruments 112.sub.1 ... 112.sub.N individually uses its ONE AND ONLY specified criteria for evaluation of its datapoint. The criteria for each of the instruments is NOT selected from ALTERNATIVE specifications.

Thus, Applicant has demonstrated that *Akash* fails to teach every element of claim 1. Because *Akash* fails to teach every element of claim 1 as required by MPEP 2131, *Akash* does not anticipate claim 1. In addition, *Akash* fails to suggest every element of claim 1. Thus, claim 1 is allowable over *Akash*.

Regarding Rejection of Dependent Claims 2-7 Under 35 U.S.C. § 102:

Because dependent claims 2-7 depend from independent claim 1, it is noted that dependent claims 2-7 have all the features described above for claim 1 as elements. As demonstrated above, independent claim 1 is not anticipated by *Akash*, nor does *Akash* suggest every element of claim 1.

Thus, *Akash* fails to teach every element of each of the claims 2-7. Because *Akash* fails to teach every element of each of the claims 2-7 as required by MPEP 2131, *Akash* does not anticipate claims 2-7. In addition, *Akash* fails to suggest every element of claims 2-7. As such, claims 2-7 are allowable over *Akash*.

Regarding Rejection of Independent Claim 8 Under 35 U.S.C. § 102:

Arguments similar to that made for independent claim 1 above are applicable to the patentability of independent claim 8. In particular, among other items, *Akasheh* does not disclose “receiving a selected one of a plurality of previously created alternative specifications for assessing a datapoint generated by a test, wherein each of the plurality of alternative specifications is a different specification for assessing the datapoint” as claim 8 of the Present Application does.

Thus, Applicant has demonstrated that *Akasheh* fails to teach every element of claim 8. Because *Akasheh* fails to teach every element of claim 8 as required by MPEP 2131, *Akasheh* does not anticipate claim 8. In addition, *Akasheh* fails to suggest every element of claim 8. Thus, claim 8 is allowable over *Akasheh*.

Regarding Rejection of Dependent Claims 9-15 Under 35 U.S.C. § 102:

Because dependent claims 9-15 depend from independent claim 8, it is noted that dependent claims 9-15 have all the features described above for claim 8 as elements. As demonstrated above, independent claim 8 is not anticipated by *Akasheh*, nor does *Akasheh* suggest every element of claim 8.

Thus, *Akasheh* fails to teach every element of each of the claims 9-15. Because *Akasheh* fails to teach every element of each of the claims 9-15 as required by MPEP 2131, *Akasheh* does not anticipate claims 9-15. In addition, *Akasheh* fails to suggest every element of claims 9-15. As such, claims 9-15 are allowable over *Akasheh*.

Regarding Rejection of Independent Claim 16 Under 35 U.S.C. § 102:

Arguments similar to that made for independent claim 1 above are applicable to the patentability of independent claim 16. In particular, among other items, *Akasheh* does not disclose a storing medium storing “a plurality of sets of previously created alternative specifications for accessing said datapoints, wherein each of the plurality of alternative specifications is a different specification for assessing the datapoint” as claim 16 of the Present Application does.

Thus, Applicant has demonstrated that *Akasheh* fails to teach every element of claim 16. Because *Akasheh* fails to teach every element of claim 16 as required by MPEP 2131, *Akasheh* does not anticipate claim 16. In addition, *Akasheh* fails to suggest every element of claim 16. Thus, claim 16 is allowable over *Akasheh*.

Regarding Rejection of Dependent Claims 17-19 Under 35 U.S.C. § 102:

Because dependent claims 17-19 depend from independent claim 16, it is noted that dependent claims 17-19 have all the features described above for claim 16 as elements. As demonstrated above, independent claim 16 is not anticipated by *Akasheh*, nor does *Akasheh* suggest every element of claim 16.

Thus, *Akasheh* fails to teach every element of each of the claims 17-19. Because *Akasheh* fails to teach every element of each of the claims 17-19 as required by MPEP 2131, *Akasheh* does not anticipate claims 17-19. In addition, *Akasheh* fails to suggest every element of claims 17-19. As such, claims 17-19 are allowable over *Akasheh*.

Regarding Rejection of Independent Claim 21 Under 35 U.S.C. § 102:

Arguments similar to that made for independent claim 1 above are applicable to the patentability of independent claim 21. In particular, among other items, *Akasheh* does not disclose a computer readable memory device comprising instructions for “receiving a selected one of a plurality of previously created alternative specifications for accessing a datapoint generated by a test, wherein each of the plurality of alternative specifications is a different specification for assessing the datapoint” as claim 16 of the Present Application does.

Thus, Applicant has demonstrated that *Akasheh* fails to teach every element of claim 21. Because *Akasheh* fails to teach every element of claim 21 as required by MPEP 2131, *Akasheh* does not anticipate claim 21. In addition, *Akasheh* fails to suggest every element of claim 21. Thus, claim 21 is allowable over *Akasheh*.

Regarding Rejection of Dependent Claims 22-24 Under 35 U.S.C. § 102:

Because dependent claims 22-24 depend from independent claim 21, it is noted that dependent claims 22-24 have all the features described above for claim 21 as elements. As demonstrated above, independent claim 21 is not anticipated by *Akasheh*, nor does *Akasheh* suggest every element of claim 21.

Thus, *Akasheh* fails to teach every element of each of the claims 22-24. Because *Akasheh* fails to teach every element of each of the claims 22-24 as required by MPEP 2131, *Akasheh* does not anticipate claims 22-24. In addition, *Akasheh* fails to suggest every element of claims 22-24. As such, claims 22-24 are allowable over *Akasheh*.

2. REJECTION OF CLAIM 20 UNDER 35 U.S.C. § 103(a):

In the section entitled “Claim Rejections - 35 U.S.C. § 103” beginning on page 6 of the Office Action of 24 November 2004, claim 20 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Akash* in view of Applicant’s alleged admitted prior art, hereinafter *AAPA*. Applicant respectfully traverses.

Referring to MPEP 2142, “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

Regarding Rejection of Claim 20 Under 35 U.S.C. § 103(a):

With respect to the rejection of claim 20 under 35 U.S.C. § 103(a), it is noted that dependent claim 20 depends from independent claim 16 and that, as such, dependent claim 20 has all the features described above for claim 16 as elements. As demonstrated above, among other items, *Akash* does not disclose a storing medium storing “a plurality of sets of previously created alternative specifications for accessing said datapoints, wherein each of the plurality of alternative specifications is a different specification for assessing the datapoint” which is an element of claim 16 of the Present Application. Nor does the alleged *AAPA* disclose such.

Thus, the cited references do not teach nor do they suggest all the claim limitations of claim 20 as required by MPEP 2142. As such, claim 20 is not obvious over *Akash* in view of the alleged *AAPA*, and it follows that claim 20 is allowable.

3. IN CONCLUSION:

Entry of this amendment is respectfully requested. Applicant believes that all claims pending in the Present Application as described above are allowable and that all other issues raised by the Examiner have been rectified. Therefore, Applicant respectfully requests the Examiner to reconsider his rejections and to grant an early allowance.

Respectfully submitted,

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